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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,833	07/21/2003	Richard A. Schumacher	MEMORY-0028	4785

23599 7590 01/16/2007
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/622,833

Applicant(s)

SCHUMACHER ET AL.

Examiner

Rebecca L. Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 and 36-113 is/are pending in the application.
- 4a) Of the above claim(s) 8-20, 23-35, 38-50, 53-65, 68-80, 83-95, 98-110 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 113 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96 and 97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 2-20 and 36-113 are currently pending in the instant application. Claims 8-20, 23-35, 38-50, 53-65, 68-80, 83-95 and 98-110 are withdrawn from consideration as being for non-elected subject matter. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96 and 97 are objected.

Response to Amendment and Arguments

Applicant's amendment and arguments filed 6 October 2006 have been fully considered and entered into the application. Applicants' amendment has overcome the following: the 35 USC 112 2nd paragraph rejection of claim 2; the 35 USC 112 2nd paragraph rejection of claims 3-5; the double patenting rejection over US Patent No. 6,699,890; the provisional double patenting rejections over 10/754600 and 10/715819; the 35 USC 102(e) rejections as being anticipated by US Patent No. 6,699,890, 2004-0230072 and US 2003/0149052; the 35 USC 103(a) rejection of claims 1 as being obvious over US Patent No. 6,699,890; the 35 USC 103(a) rejection of claim 1 as being obvious over US Pre-Grant Publication No. 20040230072; the 35 USC 103(a) rejection of claim 1 as being obvious over US Pre-Grant Publication 200310149052; the 102(b) rejection of non-elected subject matter as being anticipated by FR 2729142; the 102(b) rejection of non-elected subject matter as being anticipated by Banks et al; and the 102(b) rejection of non-elected subject matter as being anticipated by US 4,542,373.

In regards to the election requirement and the claim objection as containing non-elected subject matter, applicant argues that the restriction requirement is not proper under 35 USC 121 and the examiner should follow 803.02. Applicant directs the

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examiner's attention to a petition decision in application no. 10/361,634. However, this argument is not persuasive as but they are not persuasive. In response to applicants' traversal, it is noted that the restriction requirement was made under 35 USC 121. 35 USC 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue to the contrary. No where do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Rather, applicant has argued that these claims are Markush claims. However, there has been no rejection made under improper Markush groups. So, here we have claims, which involve more than one independent or distinct inventions. Under 35 USC 121, the claims may be restricted and the examination limited to a restricted invention. The issue here is one of restriction. 35 USC 121 gives the Commissioner the authority to restrict to one invention those applications which contain two or more inventions, i.e. limit the examination of an application to a single invention. Thus, the requirement to restrict in this application is predicated on the fact that the elected subject matter taken as a whole and the non-elected subject matter taken as a whole are so different in structure and element as to be patentably distinct, i.e. a reference which anticipated but one group of compounds

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would not even render obvious the other group. Applicants further traverse the restriction requirement base on its intra-claim restriction. Again, it is noted that the restriction requirement here is predicated on the premise that the various compounds involved (I.e. the elected and non-elected compounds) differ in structure and element so much so as to be patentably distinct. So, here we have claims, which involve more than one independent or distinct invention. Under 35 USC 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly, restriction as has been presented in this application is proper.

Therefore, as stated on pages 3 and 4 of the restriction requirement, **the elected invention for search and examination** is maintained as:

The products of formula I wherein:

R1 is H and alkyl as defined in claim 2;

R2 is Alkyl as defined in claim 1,

Cycloalkyl as defined in claim 1,

Cycloalkylalkyl as defined in claim 1,

Aryl as defined in claim 1,

Arylalkyl as defined in claim 1, and

A partially unsaturated carboxylic group having 5 to 14 carbon atoms as defined in claim 1;

R3 is Heteroarylalkyl group, wherein the heteroaryl is pyridyl, the alkyl portion, which is branched or unbranched, has 1 to 5 carbon atoms, the heteroarylalkyl group is unsubstituted or substituted one or more times in the heteroaryl portion by

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halogen, alkyl, alkoxy, cyano, trifluoromethyl, CF₃O, nitro, oxo, amino, alkyl amino, dialkylamino, or combinations thereof and/or substituted in the alkyl portion by halogen, cyano, or methyl or combinations thereof;

R4 is Cycloalkyl as defined in claim 1 and aryl as defined in claim 1;

R5 is H,

Alkyl as defined in claim 1,

Alkylamino or dialkyl amino as defined in claim 1,

A partially unsaturated carbocycle-alkyl group as defined in claim 1,

Cycloalkyl as defined in claim 1,

Cycloalkylalkyl as defined in claim 1,

Aryl as defined in claim 1 and

Arylalkyl as defined in claim 1;

L is as defined as in claim 1;

R6 is as defined in claim 1 and the products of claim 113.

Maintained Claim Objections

Claims 1-7, 21, 22, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97 and 111-112 are objected to as containing non-elected subject matter. Claims 1-7, 21, 22, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97 and 111-112 presented drawn solely to the elected invention for search and examination as identified supra would overcome the instant objection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

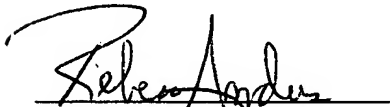
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Rebecca Anderson", is written over a horizontal line.

Rebecca Anderson
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

January 8, 2007